

### REMARKS

Applicants' counsel would like to thank the Examiner for meeting with him in a personal interview on December 6, 2004. The Examiner's Interview Summary for that interview is a complete and proper recordation of the substance of the interview with the exception that Applicant's counsel and the Examiner discussed amending the claims or adding claims to include the features recited in the Interview Summary. Applicants acknowledge receipt from the Examiner of an English translation of DE 40 35 939 A1. Applicants were not aware that the Examiner was having this reference translated and had their own translation prepared. The translation prepared for Applicants is being submitted with an Information Disclosure Statement.

Applicants have carefully reviewed the Application in view of the Office Action dated August 31, 2004. Claims 1-4, 6, 8, 13-15, 25, 28, and 29 are currently pending in the application and stand rejected. Claims 1, 25 and 29 have been amended. Claims 42-45 have been added. For the reasons provided below, Applicants submit that the pending claims are patentably distinguishable over the cited references.

The Examiner has rejected Claims 1-4, 6, 8, 25 and 28 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,755,022 by Whittlesey ("*Whittlesey*") in view of German Patent No. DE 4035939 (the "*German Patent*"). Applicant respectfully traverses these rejections for the following reasons.

Claim 1 has been amended to more distinctly claim the invention. Applicant submits that the rejection of claims 1-4, 6, and 8 is moot in view of the amendment to Claim 1. Claim 1 adds "a source of compressed gas adapted to direct a flow of gas onto the string loop" and "the compressed gas impinging on the string loop so that the string loop is transferred into the entry and into the slot. . . ." Neither *Whittlesey* nor the *German Patent* teach use of the foregoing compressed gas limitations, nor would use of a compressed gas source be obvious.

The Examiner cites U.S. Patent No. 5,842,915 to Plewa et al. ("*Plewa et al.*") as disclosing an air source in connection with his rejection of Claim 29. The Examiner states: "Plewa et al. does disclose an air source directs [*sic*] the loop into the slot - see for example figures 1-8 and columns 1-7." Office Action, page 9. While *Plewa et al.* does disclose a

compressed air source, *Plewa et al.* does not use the compressed air source to impinge on a string loop "so that the string loop is transferred into the entry and into the slot in the clipping device." Instead, *Plewa et al.* uses the compressed air source to determine if the rear end of a label is located properly. See, particularly, column 6, lines 18-27 of *Plewa et al.*

Claims 2-4, 6, 8, 13-15 and 42-44 each include all of the limitations of claim 1 and are allowable for reasons set forth with respect to Claim 1.

Claim 25 has been amended to recite that the string loop is flexible, includes a knot, and a portion of the string loop including the knot protrudes through the entry into the slot.

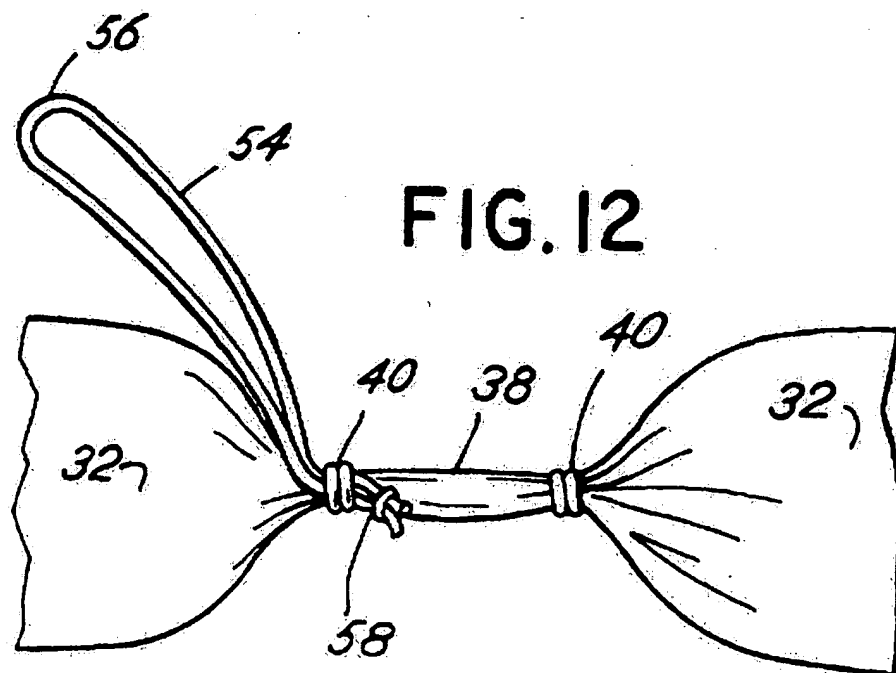
Applicant respectfully submits that the rejection of Claims 25 and 28 is improper because there is no showing of the required motivation to combine *Whittlesey* with the *German Patent* to disclose, teach, or suggest the limitations recited in Claims 25 and 28. According to the Examiner in the Office Action mailed August 31, 2004, *Whittlesey* "does not disclose that a first portion of the string loop protrudes through the entry into the slot while a second portion of the string loops [*sic*] is held simultaneously to the tape." Office Action, page 4. The Examiner looks to the *German Patent* for disclosure of this limitation. The Examiner states that it would have been obvious to one of ordinary skill in the art to take the device of *Whittlesey* and add the string loop protruding through the slot while being held to the tape of the *German Patent*, so as to allow for the clip to remove the string loop from the tape without the need of any intervening devices. Office Action, page 4.

However, in order to modify a reference in an effort to produce the claimed invention, there must be some suggestion or motivation for such modification found in the reference itself or in the knowledge generally available to one of ordinary skill in the art at the time of the invention. M.P.E.P. § 2143.01. Further, in establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide evidence supporting why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Here, the Examiner has not cited any language in *Whittlesey* or the *German Patent* or information commonly known to those skilled in the art that provides the necessary motivation or suggestion to combine the references. Rather, the Examiner merely asserts that the combination would have been obvious "so as to allow for the clip to remove the string loop from the tape without the need of any intervening devices." Office Action, page 4. However, nowhere does *Whittlesey* disclose, teach, or suggest a need for modification of its string delivery device, let alone the modification disclosed in the *German Patent*. *Whittlesey* teaches an improved string delivery device. *Whittlesey* does not suggest the need for further changes. *Whittlesey* teaches the importance of feeding the knot end of the loop under the clip:

One desired characteristic for such an improved feeding operation is to provide that the tied end of the loop, which typically has a knot thereon and thus has a diameter which is increased relative to the cord forming the loop, be positioned under the clip in a fashion which will enhance attachment of the loop to the casing by the clip when the loop is hung on a rack. That is, the loop end of the loop will be positioned on one side of the clip in order to enable that loop end to be attached to a hook. The tied end of the loop will be positioned on the opposite side of the clip and, thus, resist removal of the loop from the clip and gathered sausage casing when the loop end is pulled.

*Whittlesey* at Col. 1, lines 52-63. Furthermore, the string delivery device of *Whittlesey* is set up to place two loop strands under the clip as clearly shown in Figure 12 of *Whittlesey*:



Nothing in *Whittlesey* motivates or suggests the need for a string delivery mechanism such as is shown in the *German Patent*. In addition, the *German Patent* teaches a device that feeds the string loops in from the loop end, contrary to the express teaching in *Whittlesey* of the desire to feed the string loops in from the knot end. Furthermore, the *German Patent* delivery device places only one of the two loop strands under the clip, rather than both of the loop strands as shown in Figure 12 of *Whittlesey*. Nothing in the *German Patent* motivates or suggests the string delivery device taught therein can be modified to reliably place the string, knot end first, with two strands under the clip, as desired by *Whittlesey* and one of ordinary skill in the art would not, therefore have combined the teachings of the two references. Thus, the suggestion or motivation required by M.P.E.P. § 2143.01 for the proposed combination of *Whittlesey* and the *German Patent* does not exist, and the Examiner has failed to identify the source of such suggestion or motivation.

Furthermore, in failing to specifically identify teachings in the cited references that would suggest or motivate one of skill in the art at the time of the invention to combine *Whittlesey* and the *German Patent*, the Examiner has used hindsight to look at the system claimed in Claims 25, 28 and 29 and then conclude that it would be obvious to combine the string delivery device of *Whittlesey* with the teachings of the *German Patent*. Measuring a claimed invention against the standard established by Section 103 requires the difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

In *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit explained that evidence of a suggestion, teaching, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.

*Id.* at 999 (emphasis added). It is for this reason that the Examiner must specifically identify the reasons one of ordinary skill in the art would have been motivated to select the references and combine them. The Examiner can satisfy the burden of obviousness in light of a combination “only by showing some objective teaching [leading to the combination].” *See, e.g., In re Fine*, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988). Although evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, the range of sources available does not diminish the requirement for actual evidence. Broad conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not “evidence.” *In re Dembiczak*, 175 F.3d at 999. Here, the broad conclusory statement of the Examiner that the combination would have been obvious “so as to allow for the clip to remove the string loop from the tape without the need of any intervening devices” is not evidence. Without this evidence, the Examiner’s rejections amount to no more than an impermissible hindsight reconstruction of Applicants’ invention.

Furthermore, modifying *Whittlesey* as suggested by the Examiner would change the principle of operation of the string delivery device disclosed in *Whittlesey* and render key features useless or inoperable. If a “proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. §2143.01 Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 25, 28 and 29.

The Examiner has rejected Claim 29 under 35 U.S.C. 103(a) as being unpatentable over *Whittlesey* in view of the *German Patent*, and further in view of U.S. Patent No. 5,842,915 to Plewa et al. (“*Plewa et al.*”). The Examiner states: “Plewa et al. does disclose an air source directs [*sic*] the loop into the slot - see for example figures 1-8 and columns 1-7.” Office Action, page 9. While *Plewa et al.* does disclose a compressed air source, *Plewa et al.* does not use the compressed air source to impinge on a string loop “so that the string loop is transferred into the entry and into the slot in the clipping device.” Instead, *Plewa et al.* uses the compressed air

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source to determine if the rear end of a label is located properly. See, particularly, column 6, lines 18-27 of *Plewa et al.* Furthermore, in failing to specifically identify teachings or the references that would suggest or motivate one of skill in the art at the time of the invention to combine *Plewa et al.* with *Whittlesey* or the *German Patent*, the Examiner has improperly used hindsight to conclude obviousness. Furthermore, Claim 29 includes all of the limitations of Claim 25 and should be allowed for the reasons set forth with respect to Claim 25.

Based on the foregoing, the Applicants respectfully submit that each element of the claims is not taught or suggested by the combination of *Whittlesey* in view of the *German Patent* or *Whittlesey* and the *German Patent* in view of *Plewa et al.* Accordingly, the Applicants respectfully request that the rejection of claim 1 and 25, along with claims 2-4, 6, 8, and 13-5, and claims 28-29, which depend from claim 1 and 25, respectively, be withdrawn, and that the Examiner allow new claims 42-45.

Enclosed is a check in the amount of \$450.00 for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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